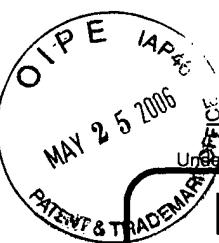


P-2006



PTO/SB/17 (10-04v2)

Approved for use through 07/31/2006. OMB 0651-0092  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# FEE TRANSMITTAL for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 250.00)

## Complete if Known

Application Number	09/684,032
Filing Date	10/6/2000
First Named Inventor	Christopher S. Nolan
Examiner Name	Charles A. Fox
Art Unit	3652
Attorney Docket No.	420-002

## METHOD OF PAYMENT (check all that apply)

Check  Credit card  Money Order  Other  None

 Deposit Account:

Deposit Account Number  
11-0978  
Deposit Account Name  
KING & SCHICKLI, PLLC

The Director is authorized to: (check all that apply)

- Charge fee(s) indicated below  Credit any overpayments  
 Charge any additional fee(s) or any underpayment of fee(s)  
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1001 790	2001 395	Utility filing fee	
1002 350	2002 175	Design filing fee	
1003 550	2003 275	Plant filing fee	
1004 790	2004 395	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
<b>SUBTOTAL (1) (\$)</b>			

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20** =	X	=
Multiple Dependent	- 3** =	X	=

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
1202 18	2202 9	Claims in excess of 20
1201 88	2201 44	Independent claims in excess of 3
1203 300	2203 150	Multiple dependent claim, if not paid
1204 88	2204 44	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
<b>SUBTOTAL (2) (\$)</b>		

\*or number previously paid, if greater; For Reissues, see above

## 3. ADDITIONAL FEES

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 430	2252 215	Extension for reply within second month	
1253 980	2253 490	Extension for reply within third month	
1254 1,530	2254 765	Extension for reply within fourth month	
1255 2,080	2255 1,040	Extension for reply within fifth month	
1401 340	2401 170	Notice of Appeal	
1402 340	2402 170	Filing a brief in support of an appeal	250.00
1403 300	2403 150	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,370	2453 685	Petition to revive - unintentional	
1501 1,370	2501 685	Utility issue fee (or reissue)	
1502 490	2502 245	Design issue fee	
1503 660	2503 330	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 790	2809 395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 790	2810 395	For each additional invention to be examined (37 CFR 1.129(b))	
1801 790	2801 395	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	
Other fee (specify) _____			
*Reduced by Basic Filing Fee Paid			
<b>SUBTOTAL (3) (\$)</b>		250.00	

(Complete if applicable)

Name (Print/Type)	Andrew D. Dorisio	Registration No. (Attorney/Agent)	41,713	Telephone	859.252.0889
Signature	5/22/06				

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Docket No. 420-002

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :  
CHRISTOPHER S. NOLAN :  
Serial No. 09/684,032 : Group Art Unit: 3652  
Filed: October 6, 2000 : Examiner: Charles A. Fox  
For: LINER FOR CONTAINER :  
WITH SIDE DOOR :

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

5/22/06

Tanya S. Mirilovich

Signature of Depositor

Date of Deposit

Name of Depositor

Signature of Depositor

APPEAL BRIEF

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed November 23, 2005, and the Notice of Panel Decision from Pre-Appeal Brief Review mailed April 12, 2006, Applicant hereby appeals the rejection of claims 1-8 and 12-18. A timely Notice of Appeal was filed on March 22, 2006. The fee for submitting this Appeal Brief may be debited from Deposit Account 11-

0978, along with any other fees required.

**I. REAL PARTY IN INTEREST**

The inventor assigned 100% of his interest in the present invention to Eagle Protective Plastics, Inc., an Indiana Corporation having a place of business at 222 West 6<sup>th</sup> Street, Jeffersonville, Indiana, 47130.

**II. RELATED APPEALS AND INTERFERENCES**

The appellant and appellant's legal representative know of no other appeals or interferences which will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

**III. STATUS OF THE CLAIMS**

Claims 1-8 and 12-18 remain pending in the application and are the subject of this appeal. Claims 9-11, 19, and 20 have been withdrawn.

Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,951,284 to Fell et al. (the “‘284 Patent”).

Claims 1, 2, 5, 6, 13, and 17 are rejected under 35 U.S.C. §103(a) as being obvious in view of the ‘284 Patent.

Claims 3, 4, 12, and 15 are rejected under 35 U.S.C. §103(a) as being obvious in view

of the ‘284 Patent in combination with U.S. Patent No. 5,028,197 to Krein et al. (the “‘197 Patent”).

Claims 7 and 8 are rejected as being obvious in view of the ‘284 Patent combined with U.S. Patent No. 5,746,862 to Derby (the “‘862 Patent”).

Claims 14 and 18 are rejected as being obvious in view of the ‘284 Patent combined with U.S. Patent 4,516,906 to Krein (the “‘906 Patent”).

Claim 16 is rejected as being obvious in view of the ‘284 Patent combined with U.S. Patent No. 3,456,834 to Paton (the “‘834 Patent”).

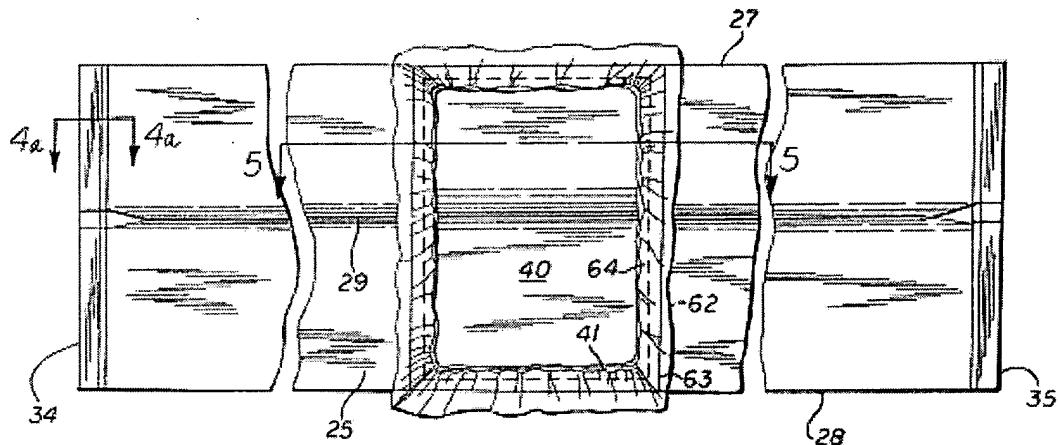
#### **IV. STATUS OF AMENDMENTS**

No amendment has been filed subsequent to the Office Action mailed November 23, 2005, and all previous amendments have been entered. With the exception of the withdrawal of claims 9-11, 19 and 20 in the Office Action mailed November 23, 2005, the form of the claims for purposes of this appeal are those presented in the Amendment submitted by the appellant on March 11, 2004. As required, appellant includes a copy of the claims in the “Claims Appendix,” *infra*.

#### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

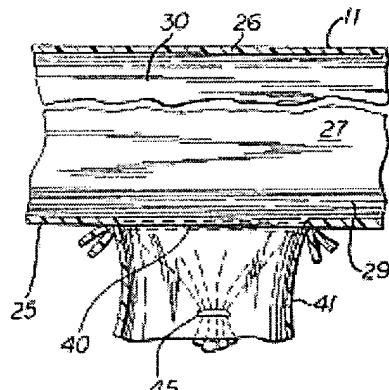
The present invention pertains to moisture proof liners for containers and, more particularly, to a liner and the related installation system where transfer of the cargo into and

out of the container is through a side door. In its broadest terms, the invention includes a liner 11 formed of impervious film having a first, elongated side panel 25, an opposite side panel 26, a top panel 27, a bottom panel 28, and first and second end panels 34 and 35:



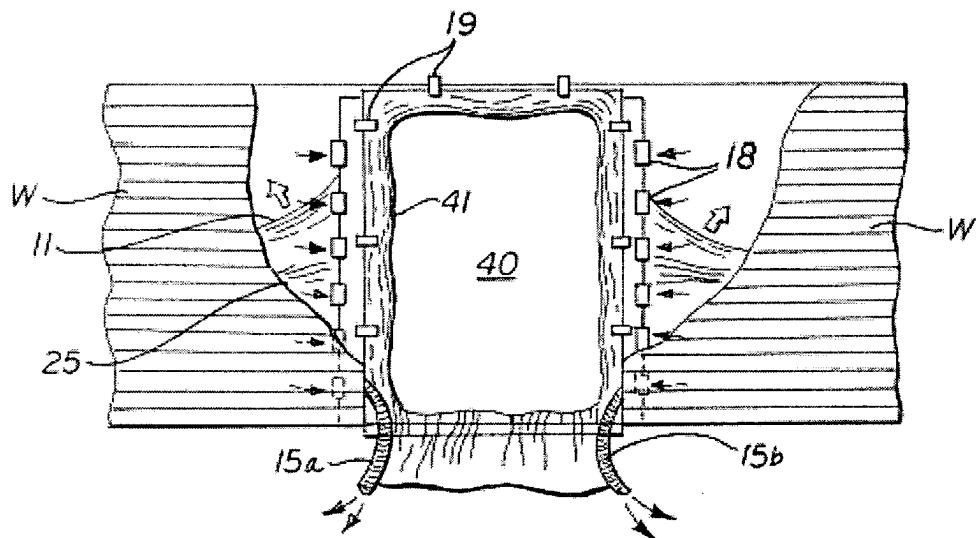
(Fig. 4, p.8, line 13-p.9, line 6).

An access opening 40 is formed in at least one side panel 25, such as for example by cutting, and is adapted for loading and unloading cargo from the side of the liner:



(Fig. 5, p.9, line 10).

Independent claim 1 relates specifically to the liner 11 comprising four elongated panels 25, 26, 27, 28 of impervious film adapted to substantially match the elongated sides, top, and bottom of a container 10 (Fig. 4, p.8, lines 19-21). First and second end panels 34 and 35 complete the liner (also Figure 4). The liner 11 also comprises an access opening 40 along at least one side panel adapted for loading and unloading cargo (Figure 2, p.9, line 10). A closure 45 is also claimed for sealing the opening 40:



(Fig.2, p.9, lines 20-22).

Claim 2 requires an open tube 41 attached at one end to extend laterally from the opening to form a passage for loading and unloading cargo (Figure 5; p. 9, line 11). Claim 3 adds to claim 2 the condition that the liner and tube are formed of plastic sheet (p.8, line 15) and that a heat seal bead 64 extends around the orifice between one side panel and the

adjacent one end of the tube 41 (Figure 4; p. 11, line 12). Claim 4 specifies a tie closure 45 formed around the tube 41 and adapted to be tucked inside the container after loading (Figure 5; p.9, line 21).

Claim 5 requires that the access opening 40 is located at approximately the mid-point of one of the side panels 25 (Figure 1; p. 10, line 1).

Claim 6 requires that the liner in claim 1 include a second access opening 40a, a tube 41a in the second side panel substantially opposite the first opening, and a closure 45a for the second opening for loading/unloading cargo (Figure 3; p. 10, line 8).

Claim 7 describes folds 29, 30 thereby allowing expansion for substantially filling the container when the panels are fully extended (Figures 4 & 5; p. 8, line 22). Claim 8 requires that the first and second end panels 34,35 are formed by folded end sections of the side panels and a heat seal bead 60 extending across the folds of the end sections (p. 10, line 22). Claim 12 relates to the liner of claim 11 in combination with a source of air 20 for erecting the liner (Fig. 1, p.8, line 10).

Independent claim 13 relates to a liner for an elongated container for use in shipping cargo comprising four elongated panels 25, 26, 27, 28 of impervious film adapted to substantially match the elongated sides, top, and bottom of a container 10, each of the elongated panels having a first length (Fig. 4, p. 8, lines 19-21). First and second end panels 34 and 35 complete the liner, each of the first and second end panels having a second length such that the first length is greater than the second length (Fig. 4, p.9, line 6). The liner 11

also comprises an access opening 40 along at least one side panel 25 adapted for loading and unloading cargo (Fig. 2, p.9, line 10). A closure 45 is also claimed for sealing the opening 40 (Fig. 2, p.9, lines 20-22).

Claim 14 specifies that the liner 11 of claim 13 is free-standing in the container (Fig. 4, p.8, lines 4-12). Claim 15 adds the requirement to claim 13 that the first and second end panels 34, 35 are free of any openings (Fig. 4, p.9, lines 6-9). Claim 16 adds the requirement to claim 13 that at least one of the side panels includes a plurality of orifices 17, 18 enabling installation of the liner via air pressure (Fig. 1, p.8, line 5)

Independent claim 17 relates to a liner for an elongated container for use in shipping cargo comprising four elongated panels 25, 26, 27, 28 of impervious film adapted to substantially match the elongated sides, top, and bottom of a container 10 (Figure 4, p. 8, lines 19-21). Uninterrupted first and second end panels 34, 35 free of any openings complete the liner 11 (Fig. 4, p. 9, lines 6-9). The liner 11 also comprises a first access opening 40 along the first side panel 25 adapted for loading and unloading cargo (Fig. 4, p. 9, line 10). It also comprises a second access opening 40a along the second side panel substantially opposite the first opening for also loading and unloading the cargo (Fig. 3, p.10, lines 8-14). Closures for said first and second openings 40, 40a to seal the liner against moisture and protect the cargo are also claimed (Fig. 2, p.9, lines 19-22). Claim 18 adds the requirement to claim 17 that the liner 11 is free-standing in the container (Fig. 4, p. 8, lines 4-12).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The Board must first determine whether the inventions set forth in claims 1, 2, 5, and 6 are anticipated under 35 U.S.C. §102(b) in view of the ‘284 Patent. Additionally, the Board must determine whether the inventions of claims 1, 2, 5, 6, 13, and 17 are “obvious” in view of the ‘284 Patent. The Board also must determine if the inventions of claims 3, 4, 12, and 15 are “obvious” in view of the ‘284 Patent combined with appellant’s ‘197 Patent. Similarly, the Board must determine if the inventions of claims 7 and 8 are “obvious” in view of the ‘284 Patent combined with the ‘862 Patent. The Board also must determine if the inventions of claims 14 and 18 are “obvious” in view of the ‘284 Patent combined with the ‘906 Patent. Finally, the Board must decide if the invention of claim 16 is “obvious” in view of the ‘284 Patent combined with the ‘834 Patent.

## **VII. ARGUMENT**

### **I. CLAIMS 1,2, 5, AND 6 ARE NOT ANTICIPATED BY THE ‘284 PATENT.**

With regard to the anticipation rejections, the ‘284 Patent fails to teach each and every limitation of claims 1, 2, 5, and 6. The examiner expressly acknowledges this point, yet maintains the rejections under 35 U.S.C. §102(b). Most recently, on page 4 of the Office Action mailed November 23, 2005, the examiner states, “. . . *Fell et al. [the ‘284 Patent] do not explicitly teach the opening in the side of the liner. . .*” (emphasis added). Instead, it merely shows the conventional opening formed in the *end panel* of the liner. As claims 1, 2,

5, and 6 clearly require “an access opening along at least one *side panel*,” appellant is baffled by the rejections since the examiner has not shown with the requisite strict identity that each and every limitation of the rejected claims is met by the ‘284 Patent (which is of course an unwavering requirement for maintaining an anticipation rejection). Accordingly, reversal of the rejections is in order.

**II. CLAIMS 1-8 AND 12-18 ARE NOT RENDERED OBVIOUS BY THE ‘284 PATENT TAKEN ALONE OR IN COMBINATION WITH OTHER PATENTS.**

**A. THE ‘284 PATENT TAKEN ALONE FAILS TO RENDER CLAIMS 1, 2, 5, 6, 13, AND 17 OBVIOUS**

As set forth above, claims 1, 13, and 17 expressly require a moisture proof liner for an elongated container for use in shipping cargo comprising four elongated panels of impervious film adapted to substantially match the elongated sides, top and bottom of the container and first and second end panels to complete the liner. An access opening is provided along at least one side panel for loading and unloading cargo. Claim 1 requires a closure that seals the liner against moisture to protect the cargo. Claim 13 requires that the end panels have a length less than the length of the other panels, while claim 17 requires that the end panels are “uninterrupted” and “free of any openings.” As explained in detail in the Background of the Invention section of appellant’s specification, the need met by the present invention is “providing a system for cargo shipping containers, characterized by a side, rather than end door for transfer of the cargo into and out of the container.” (p. 2, lines 17-19).

### **1. THE ‘284 PATENT FAILS TO TEACH OR SUGGEST THE LIMITATIONS OF THE CLAIMS**

The inventions recited in claims 1, 13, and 17 are in stark and total contrast to the liner disclosed in the ‘284 Patent, which as admitted by the Examiner simply does not teach a liner having an opening on a *side panel* corresponding to the top, bottom, or side of an elongated container. Rather, it shows the conventional opening formed in the *end panel* of the liner, which obviously would not meet the need identified by the appellant and fulfilled by the inventions of claims 1, 13, and 17. Accordingly, since these claims clearly distinguish between the end panels and the side panels and plainly describe the location of the opening, it is believed that the ‘284 Patent does not suggest the inventions claimed therein. Since no other evidence is cited as allegedly supplying the teaching missing from this reference or suggesting this modification, it is respectfully submitted that a *prima facie* case of obviousness is lacking. *See* Manual of Patent Examining Procedure § 2143.03 (stating that “[t]o establish *prima facie* obviousness of a claimed invention, ***all claim limitations must be taught or suggested by the prior art***”) (emphasis added) (citations omitted).

Precedential decisions of the Court of Appeals for the Federal Circuit fully support appellant’s position in this regard. For example, in the decision of *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992), the Federal Circuit overturned an Examiner’s determination regarding the obviousness of a claimed invention. In the course of doing so, it explained that:

[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.*

*Id.* at 1784 (emphasis added). The highlighted point was further emphasized in the more recent decision of *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), in which the court held that the Board of Patent Appeals and Interferences improperly relied upon “common knowledge and common sense” of a person of ordinary skill in the art to find a claimed invention obvious. Instead, the court emphasized the need for “*objective evidence*” on this point, as opposed to subjective speculation.

Here, not even a scintilla of objective evidence indicates that anything in the prior art “suggested” the proposed modification to the liner disclosed in the ‘284 Patent. Rather, the Examiner takes “official notice” that “it would be obvious...to place the opening at a location in the liner corresponding to where there is an opening in the container.” While it is easy for the Examiner using hindsight to conclude subjectively that the inventions of claim 1, 13, and 17 are “obvious,” ostensibly because it is not terribly complex technology, the position advanced fails to consider that the only suggestion in the ‘284 Patent is to provide a liner with an opening in a narrow end panel. While the end opening admittedly corresponds to the door of the container, this does not fairly support the conclusion that it would thus be “obvious”

to provide the opening in a different, elongated side panel of the liner, merely to accommodate a door in a type of container not even shown in the reference. This is simply speculation based on hindsight using the appellant's teaching as a blueprint, which is of course never proper. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation" to make a modification as an "essential evidentiary component of an obviousness holding"); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.").

**2. THE EXAMINER'S PROPOSED MODIFICATION WOULD CHANGE THE PRINCIPLE OF OPERATION THE INVENTION DESCRIBED IN THE '284 PATENT**

Appellant concedes that the '284 Patent "suggests" and, in fact, expressly discloses providing an opening in an end panel of a liner. However, if a "similar" liner with the opening in the end panel disclosed in the '284 Patent were used in an elongated container with a side door, *it would not work!* This is because the liner disclosed in this patent includes elongated sides and short ends, and it is one of the short ends that includes the "access" opening. If such a liner were inserted in a container with a side door, the elongated side panels would face the short ends of the container when erected, and thus would not match (as required in claims 1, 13, and 17). Moreover, these elongated sides could not be moved into contact with the ends of the container in an easy and efficient manner, such as by using

positive or negative air pressure. Instead, some deformation or stretching of these panels would be required to make the rearrangement, which is not only extraordinarily difficult to accomplish, but also deleteriously risks tearing or perforating the liner (which even the ‘284 Patent acknowledges is of critical importance). Since a moisture-proof liner is required by the industry, such tearing would essentially render it ineffective for its intended purpose. Section 2143.01 of the Manual of Patent Examining Procedure provides that “[i]f the proposed modification . . . of the prior art would change the principle of operation of the prior art invention being modified, *then the teaching . . . [is] not sufficient to render the claims prima facie obvious.*” (emphasis added). In this instance, modifying the liner in the Examiner proposed manner would “change the principle of operation” of the “prior art invention” disclosed in the ‘284 Patent, which at col. 7, ll. 47-48 explains that “[o]nce the container has reached its destination *some means must be provided to tilt the container.*” (emphasis added). Moreover, this patent teaches that “. . . as the container empties it is tipped to allow the bulk material to flow down *towards the unloading end of the liner*” (col. 8, ll. 4-6, emphasis added).

Clearly, the inventors of the technology shown in the ‘284 Patent only contemplated having an opening in the *end* of the liner, *not in the side panel* of the liner as required by claims 1, 13, and 17. Furthermore, modifying the liner as proposed would not allow for the desired “flow” of materials discussed in the ‘284 Patent as being an advantage of the invention. Even if a corresponding container, such as a rail car, was capable of tilting on its

side, the contents of the container would not flow to the unloading *end* of the liner. Instead, only a portion of the contents would exit the side opening of the container, while the remainder would be pressed against the side wall of the container. Since the proposed liner modification would dramatically change the operation of “prior art invention” disclosed in the ‘284 Patent, the *prima facie* case of obviousness is lacking. Moreover, there is absolutely no mention of the “uninterrupted” end panels, “free of any openings,” as required by claim 17. In fact, use of such “uninterrupted” end panels would render the ‘284 Patent inoperative because the cargo could not be unloaded in the only manner taught by this patent.

During prosecution, the only passage cited by the Examiner as allegedly suggesting the proposed modification merely states that “. . .there is provided a device for transporting bulk material in a shipping vehicle *having walls, one of which defines a door opening* and doors attached thereto. . .” ‘284 Patent, Col. 2, ll. 25-28 (emphasis added). Rather than suggesting that “the door to the container can be in any of the walls to the container,” this passage merely states that one of the *walls* defines a *door opening*. To stretch this passage as proposed would require the entire elongated side wall of the container “define” a door opening. Not only would this result in a structurally unsound container, but it would render the ‘284 Patent inoperable. In particular, if the entire side wall defines the door of the container, portions of the liner would simply fall out of the container when it is tilted, as *must* be done for emptying the contents of the container according to the ‘284 Patent. Clearly, this is not the end result desired by this patent, which teachings must be construed in *pari materia* rather than in the

piecemeal approach taken by the Examiner. *See MPEP § 2141.03 (“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.”) (emphasis added).*

**3. THE EXAMINER’S PROPOSED MODIFICATION WOULD REQUIRE A COMPLETE REDESIGN OF THE INVENTION DESCRIBED IN THE ‘284 PATENT**

Additionally, if a second access opening is added to the elongated side panel of the ‘284 Patent liner to accommodate a container with a side door, the Examiner fails to explain how one would deal with the openings on the end panel, which would ostensibly face a side wall of the container and would be rendered useless. If the position is that the end openings would simply be moved to the side, this is a *structural modification* of the prior art without any teaching or suggestion to do so. Even if this patent is presumed to disclose that the opening is provided adjacent to a door in the container, this cannot be considered *per se* to teach or suggest what is now being claimed: a liner with an elongated side having an access opening, which is intended for use in a container having a side door, when in fact there is nothing in the reference to suggest such an arrangement.

Simply put, the ‘284 Patent does not even contemplate providing an access opening in an elongated side panel of a liner, as opposed to the end panel. Rather, like all cited prior art, it simply discloses the conventional access opening in the end panel. As explained above, the two liners are not interchangeable, and no prior art arising in the nearly 30 years since the application that matured into the ‘284 Patent is identified that suggests the modification made by the appellant, as now embodied in claims 1, 13, and 17. This belies the position that it

would have been “obvious” to simply place the opening at the location corresponding to the door in the container, which is based on subjective speculation alone, rather than the “objective” evidence that the precedential case decisions expressly require.

As noted above, the suggested rearrangement requires a substantial reconstruction or redesign of the liner described therein or, stated another way, a “structural modification.” In the case of *In re Ratti*, 270 F.2d 810 123 USPQ 349 (CCPA 1959), the Court of Customs and Patent Appeals encountered a similar situation regarding an examiner’s assertion of “obviousness” that would have required a substantial redesign of the device disclosed in the prior art. The CCPA found that the examiner’s assertion of “obviousness” was improper because the combination of references relied on required “substantial reconstruction and redesign of the elements shown.” Specifically, the court observed that:

[w]e hold, further, that the combination of [references] . . . is not a proper ground for rejection of the claims here on appeal. This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [reference 1] as well as a change in the basic principles under which the . . . construction was designed to operate. Once appellant had taught how this could be done, the redesign may, by hindsight, seem to be obvious to one having ordinary skills. . . However, when viewed as of the time appellant’s invention was made, and without the benefit of appellant’s disclosure, we find nothing in the art of record which suggest appellant’s novel [invention] . . .

*Id.* at 352 (emphasis added). Similarly, in *Ex parte Chicago Rawhide Manufacturing Company*, [NO WEST CITE] 223 USPQ 351(Bd. Pat. App. & Inter.1984), the Board rejected an examiner’s assertion of “obviousness,” recognizing that the elements of the cited prior art must be arranged in a different manner from that disclosed in the cited references.

In particular, the Board observed that:

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness.

*Id.* at 353 (emphasis added).

As admitted by the present examiner, the ‘284 patent *only* shows the conventional opening formed in the end panel of the liner, and suggests that a “similar” liner (i.e., one with an opening in a narrow end) could be “applied to a shipping vehicle having side walls.” Just like in *Ex parte Chicago Rawhide* and *In re Ratti*, the assertion that it would be “obvious” to rearrange the prior art liner to have an opening on an elongated side panel is specious, since such would require a “substantial reconstruction and redesign of the elements” of the ‘284 patent. As observed by the Board in *Ex parte Chicago Rawhide, supra*, “[t]he prior art must provide a motivation or reason for the worker in the art, ***without the benefit of the appellant’s specification***, to make the necessary changes in the reference device.”(emphasis added). As fully established above, such motivation or reason to make the changes in the reference device that the Examiner suggests is lacking in the present record. Therefore, the rejections of claims 1, 13, and 17 on “obviousness” grounds are wholly improper and must be reversed.

The rejections of dependent claims 5 and 6 must also fail for similar reasons. Claim 5 requires that the opening is ***along the mid-point*** of one of the elongated side panels. Since the ‘284 Patent does not even teach providing such an opening in a side panel, it certainly

cannot teach or suggest providing it at a mid-point of an elongated panel. Moreover, even if the opening in the liner disclosed in the ‘284 Patent were provided at the mid-point of the end panel (which it is not, and the examiner does not contend otherwise), it is emphasized that this liner would not work in a container with a side door, since the elongated sides of that liner would not “substantially” match the corresponding sides of the container. Rather than explaining why the ‘284 Patent or something else in the art suggests providing the opening at the midpoint, the Examiner simply makes a “shotgun” rejection of this claim without providing any substantive analysis. The specific requirements of the claim are ignored, which is reversible error. *See MPEP § 2143.03 (8<sup>th</sup> ed., rev. 1, February 2003)* (recognizing in the obviousness context that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”).

As for claim 6, the examiner contends that the ‘284 Patent teaches “access openings for containers having openings on one or more sides depending on the configuration of the container,” but cites to no portion of the document as supplying this teaching. Appellant’s Counsel has scoured this reference, but finds that it is limited to providing one or more access openings on a *single end panel* of a liner. It simply does not contemplate providing openings in a second side panel substantially opposite the first opening, as expressly required by the claim. This is because the ‘284 Patent liner is for use on a trailer or other container including doors on only a single end. Thus, it certainly cannot “suggest” this modification, and no other convincing line of reasoning is proffered to explain why a skilled artisan would

want to provide a second opening at the opposite end of the liner disclosed in the ‘284 Patent, when the opening would simply face the end wall of the trailer near the cab, which is *always* closed.

**B. THE ‘284 PATENT IN COMBINATION WITH THE ‘197 PATENT FAILS TO RENDER CLAIMS 3, 4, 12, AND 15 OBVIOUS**

With regard to claims 3 and 4, the examiner admits that the ‘284 Patent fails to “teach the liner and tubes as being a plastic sheet material joined by heat welding of the mating surfaces.” However, the ‘197 Patent also fails to supply this teaching, and the record otherwise lacks any objective evidence of it. The ‘197 Patent *never* makes direct reference or allusion to a liner with “an access opening along at least one side panel,” nor a liner and “open tube” formed of plastic sheet and a heat seal bead.

Similarly, with regard to claim 12, the ‘197 Patent *never* mentions use of an air source in conjunction with a liner with “an access opening along at least one side panel.” As for claim 15 requiring end panels free of any openings, the examiner provides absolutely no support for his assertion of obviousness. This is likely because the patents cited in support of the rejection disclose precisely the opposite.

In view of these deficiencies in the examiner’s rejections and the teachings of these patents, no *prima facie* case of obviousness has been established for claims 3, 4, 12, and 15.

**C. THE ‘284 PATENT IN COMBINATION WITH THE ‘862 PATENT FAILS TO RENDER CLAIMS 7 AND 8 OBVIOUS**

Similarly, with regard to claims 7 and 8, the examiner again fails to identify where the ‘284 and ‘862 Patents teach or suggest each and every limitation of these claims. Claim 7 clearly requires that “the side panels include folds to allow expansion.” Nowhere does the ‘862 Patent show side panels including folds to allow expansion, nor does the examiner make an assertion to the contrary. Instead, the examiner identifies the “opposing horizontal gussets 22 and 24,” as constituting these folds. Even if one were to construe the gussets 22 and 24 as the folds in claim 7, they are not in the *side panels!* The ‘862 Patent only shows gussets in the end panels.

Moreover, claim 8 further requires that the end panels are formed by “folded end sections” of the side panels and a heat seal bead extending across the folds. The examiner’s rejection simply does not cite the necessary substantial, objective evidence to support a *prima facie* case of obviousness, since each and every limitation required is not found in the combination of the ‘284 and ‘862 Patents.

**D. THE ‘284 PATENT IN COMBINATION WITH THE ‘906 PATENT FAILS TO RENDER CLAIMS 14 AND 18 OBVIOUS**

With regard to the requirement of claims 14 and 18 that the claimed liner is freestanding, the ‘284 Patent goes to great lengths to discuss an elaborate connector system

to retain the liner. In contrast, the ‘906 Patent teaches a liner that does not require an elaborate connector system. The author of the ‘906 Patent agrees with this assertion, as he or she disparages the ‘284 Patent in the “Description of Prior Art” (‘906 Patent, col. 1, ll. 35-40).

The Federal Circuit has held that “[e]lements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents.” *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis added). There is clearly no suggestion of a free-standing liner with a side panel opening anywhere in the ‘284 or ‘906 Patents. Indeed, the ‘906 Patent teaches away from such by requiring an elaborate connector system. Accordingly, the cited combination of patents is improper and fails to establish a case of *prima facie* obviousness.

#### **E. THE ‘284 PATENT IN COMBINATION WITH THE ‘834 PATENT FAILS TO RENDER CLAIM 16 OBVIOUS**

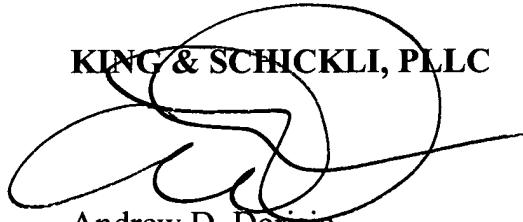
Claim 16 requires “a manifold including a plurality of orifices for enabling installation of the liner via air pressure.” In the November 23, 2005 Office Action, the examiner never identifies where either of the ‘284 or ‘834 Patents teach this limitation. Instead, he makes several unsubstantiated allegations regarding these patents (See Nov. 23 Action, p. 6). Since neither the ‘284 nor the ‘834 Patent teach or suggest the “manifold” of claim 16, and the examiner has failed to even make an attempt at establishing a case of *prima facie*

obviousness, this claim should be allowed.

In summary, appellant has addressed and met every rejection set forth in the final Office Action and asseverates that all of the rejected claim meet the statutory requirements for patentability. Thus, it is respectfully requested that all outstanding rejections of claims 1-8 and 12-18 be reversed and that the present application be remanded to the examiner with instructions for immediate allowance.

Respectfully submitted,

**KING & SCHICKLI, PLLC**



Andrew D. Dorisio  
Registration No. 41,713

247 North Broadway  
Lexington, Kentucky 40507  
(859) 252-0889

### **VIII. CLAIMS APPENDIX**

The claims on Appeal read as follows:

1. (Original) A moisture proof liner for an elongated container for use in shipping cargo, comprising:

four elongated panels of impervious film adapted to substantially match the elongated sides, top and bottom of said container;

first and second end panels to complete said liner;

an access opening along at least one side panel adapted for loading and unloading said cargo; and

a closure for said opening to seal said liner against moisture to protect the cargo.

2. (Original) The liner of Claim 1, wherein said access opening includes an open tube attached at one end to extend laterally from said opening to thereby form a passage for loading and unloading said cargo.

3. (Original) The liner of Claim 2, wherein said liner and said tube are formed of plastic sheet and a heat seal bead extending around said orifice between said one side panel and the adjacent one end of said tube.

4. (Original) The liner of Claim 3, wherein said closure is formed by a tie around the tube adjacent the other end and adapted to be tucked inside said container after loading.

5. (Original) The liner of Claim 1, wherein the access opening is approximately at the mid-point of said one side panel.

6. (Original) The liner of Claim 1, wherein is provided a second access opening

including a tube in the second side panel substantially opposite the first opening for also loading/unloading said cargo and a second closure for said second opening.

7. (Previously Presented) The liner of Claim 1, wherein the side panels include folds to allow expansion for substantially filling said container when said panels are fully extended.

8. (Previously Presented) The liner of Claim 7, wherein said first and second end panels are formed by folded end sections of the side panels and a heat seal bead extending across the folds of said end sections.

9.-11. (Withdrawn)

12. (Previously Presented) The liner of claim 1 in combination with a source of air for erecting the liner.

13. (Previously Presented) A liner for an elongated container for use in shipping cargo, comprising:

four elongated panels of impervious film adapted to substantially match the elongated sides, top and bottom of said container, each of said elongated panels having a first length;

first and second end panels to complete said liner, each of said first and second end panels having a second length less than the first length; and

an access opening along at least one side panel adapted for loading and unloading said cargo.

14. (Previously Presented) The liner of claim 13, wherein said liner is free-standing when erected in said container.

15. (Previously Presented) The liner of claim 13, wherein said first and second end panels are free of any openings.

16. (Previously Presented) The liner of claim 13 in combination with a manifold including a plurality of orifices for enabling installation of the liner via air pressure.

17. (Previously Presented) A liner for an elongated container for use in shipping cargo, comprising:

elongated top, bottom, first side and second side panels of impervious film adapted to substantially match the elongated top, bottom and sides of said container;

uninterrupted first and second end panels free of any openings to complete said liner;

a first access opening along said first side panel adapted for loading and unloading said cargo; and

a second access opening along said second side panel substantially opposite said first opening for also loading and unloading said cargo.

18. (Previously Presented) The liner of claim 17, wherein said liner is free-standing when erected in said container.

19.-20. (Withdrawn)

**IX. EVIDENCE APPENDIX**

NONE

**X. RELATED PROCEEDINGS APPENDIX**

NONE